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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,501	01/22/2002	Rebecca Klotzer	3568.075	8934
152	7590	12/01/2004		
CHERNOFF, VILHAUER, MCCLUNG & STENZEL 1600 ODS TOWER 601 SW SECOND AVENUE PORTLAND, OR 97204-3157			EXAMINER BISSETT, MELANIE D	
			ART UNIT 1711	PAPER NUMBER

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/055,501

Applicant(s)

KLOTZER, REBECCA

Examiner

Melanie D. Bissett

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-10, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. The rejections have been withdrawn based on the applicant's amendments.

However, new rejections have been included.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6-10 and 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 6 has been amended to include the limitation "in the absence of a nucleating agent". However, the applicant has not pointed to where the present specification teaches such a limitation. It is the examiner's position that the original specification does not guide one of ordinary skill in the art to specifically *exclude* such a material. The mere absence of a positive recitation is not basis for exclusion. See MPEP 2173.05(i).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalaby et al.

6. Shalaby discloses a highly uniform microporous foam structure suitable for several applications (abstract). Because the reference discloses using the microporous foam in thin layers for applications such as filtration and biomedical materials (col. 1 lines 10-24), it is the examiner's position that the reference teaches the foam as a membrane structure. The microporous foams of the invention are made from thermoplastics such as polyamides, polyesters, and polyolefins (col. 3 lines 57-66) and can be tailored to possess the desired pore size (col. 4 lines 2-11) and void fraction (col. 8 lines 36-39). For biomedical applications, preferred pore sizes are from 5 to 200 microns (col. 6 lines 20-29), and the preferred void fraction is 50-80% by volume (col. 8 lines 44-48). Although Shalaby refers to foams of the invention as having uniform, continuous open cells (col. 4 lines 48-51), the reference does not indicate proportions of open cells or standard deviation of open-pore size distribution.

Regarding the proportions of open cells, it is noted that the reference teaches continuous open cells or voids and also teaches a method of forming the foams by introducing a fugitive compound into the polymeric material that is later removed. Because of the process used and because the reference teaches how to form foams of very high void fractions, it is the examiner's position that one of ordinary skill in the art would recognize that the claimed amount of open cells could be achieved. Also, because open cells are needed to provide the porous nature of the biomedical foams, it would have been prima facie obvious to form foams having any amount of open cells necessary to optimize porosity of the materials.

Regarding the standard deviation of the open cells, it is noted that highly uniform foams are required for the foams of the invention (abstract). Since the reference teaches methods of controlling the cell size of the foams as dependent on the fugitive materials used (col. 7 lines 41-63), it is the examiner's position that one of ordinary skill in the art would recognize how to form uniformly-sized cells fitting the applicant's standard deviation. Since uniformity is a concern of the invention, it is the examiner's position that it would have been prima facie obvious to control the cell sizes in a manner to optimize cell size uniformity.

7. Regarding the process limitations including cell-forming fluids, it is noted that the claims are written in product-by-process format. Since the reference and present application are drawn to open-celled foam materials, the cell forming agents used in the materials escape the foam structure and are no longer part of the material structure. However, it is the examiner's position that it would have been obvious to form the foamed membranes having the claimed properties. For this reason, it is the examiner's position that the materials of the reference would be indistinguishable from those of the claimed invention, regardless of cell forming agent used. The applicant has not shown how the process would produce a materially different product.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 6-10 and 18-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

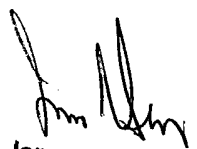
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdb



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